

ATTORNEY'S DOCKET NO.: Bu221/7049

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Mulhauser et al.
Serial No. : 07/886,689
Filed : May 20, 1992
For : IMPLANTABLE PROSTHESIS AND METHOD AND APPARATUS
FOR LOADING AND DELIVERING AN IMPLANTABLE
PROSTHESIS
Examiner : Nguyen, D. FAX COPY MAY 1994
Art Unit : 3308
Batch No. : 535 MAY 25 1994

HON. COMMISSIONER OF PATENTS AND TRADEMARKS
WASHINGTON, D.C. 20231
ATTENTION: DIRECTOR GROUP 330

GROUP 3300

Sir:

PETITION FOR WITHDRAWAL OF APPLICATION FROM ISSUE
PURSUANT TO 37 C.F.R. §1.313

Applicants respectfully request that the above-referenced application be withdrawn from issue pursuant to 37 C.F.R. §1.313.

This application is scheduled to issue as patent no. 5,318,559 on June 7, 1994. As more fully explained below, in order for the Examiner to have sufficient time to consider whether an interference should be declared between the instant application and recently issued patent no. 5,304,187 (see attached Information Disclosure Statement), this case should be withdrawn from issue.

On the afternoon of Wednesday last, May 18, 1994, the undersigned representative of Applicants conducted a database search of the Lexis database, Patent library, utility file, in connection with an unrelated matter and located newly issued (April 19, 1994) patent no. 5,304,187 ("187 patent"). After

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studying the '187 patent over the next several days, it became apparent that there was interfering subject matter amongst the '187 patent and the soon to issue application. Without limiting applicants position in this regard, in any way whatsoever, it is submitted that there appears to be interfering subject matter between claims 48, 59-62, 73 and 75-76 of the pending application and claims 25-30 of the '187 patent.

Attempts on the following Monday (May 23, 1994) to reach Examiners Nguyen and Green by telephone were unsuccessful. The next day (Tuesday May 24, 1994) a face-to-face meeting was held between the undersigned and Examiners Nguyen and Green to discuss the available procedures for having the '187 patent considered by the patent office before the imminent issuance of the application. The Examiners willingness to meet without advance notice is noted and appreciated.

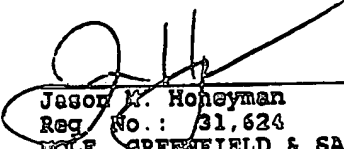
It was agreed that this petition under 37 C.F.R. 1.313 should be filed, directed to the attention of the Group Director, to ensure enough time for Examiner Nguyen to consider whether an interference should be provoked and whether the '187 patent otherwise should be applied against the claims of the allowed application. [It is noted that the '187 patent has a later filing date than the soon to issue application and, accordingly, the undersigned believes that the pertinent statutory consideration would be §102(g) and not §102(e)]. Allowing

Examiner Nguyen to consider the '187 patent also would shield Applicants from an unwarranted, but likely, charge of a Rule 56 violation if there is infringement litigation in the future.

It was suggested by the Examiners that this petition be filed as promptly as possible. Accordingly, this Rule 1.313 petition and the accompanying Information Disclosure Statement are being submitted by facsimile transmission. It is again noted that the above-referenced application is scheduled to issue on June 7, 1994. The immediate granting of this petition, withdrawal of the case from issue and return of the application to the examiner for consideration of the '187 patent is therefore requested.

The Group Director is kindly requested to telephone the undersigned either if he wishes to discuss this matter further or to apprise the undersigned of the decision on petition in case Applicants will be required to consider other avenues for addressing this situation.

Respectfully submitted,



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